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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/657,837

09/09/2003

Mark A. Reiley

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05/20/2010

SHAY GLENN LLP
2755 CAMPUS DRIVE
SUITE 210
SAN MATEO, CA 94403

EXAMINER

PRONE, CHRISTOPHER D

ART UNIT

PAPER NUMBER

3738

MAIL DATE

DELIVERY MODE

05/20/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|---|--|--|
| Office Action Summary | Application No. 10/657,837 | Applicant(s) REILEY, MARK A. | |
| | Examiner CHRISTOPHER D. PRONE | Art Unit 3738 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13-16, 18-28 and 30 is/are pending in the application.
- 4a) Of the above claim(s) 3, 7, 10 and 20-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-6, 8, 9, 11, 13-16, 18, 19, 23-28 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :3/8/10 6/12/06
9/22/05 6/20/05 3/8/05 11/4/04 11/3/04 9/9/03.

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DETAILED ACTION

Status of Claims

Claims 12, 17, and 29 are cancelled.

Claims 1-11, 13-16, 18-28, and 30 are pending.

Claims 3, 7, 10, 20-22 remain withdraw.

Claim Objections

Claim 30 objected to because of the following informalities: contrary to the elected embodiment.

The claim requires a hexagonal shaped depression, but it is clear from the figure referenced by the applicant (2a), that the depression is Pentagonal shaped.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4-6, 8, 9, 11, 13-16, 18, 19, 23-28, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zang et al (USPN 5,314,486) in view of Vitale (USPN 5,683,466).

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Zang, et al discloses a prosthesis comprising a fastening element, and an artificial joint structure comprising a facet joint surface carried by the fastening element. The prosthesis of Zang, et al is fabricated from selected biocompatible materials including titanium, cobalt chrome, or polyurethane and may be fastened to the bone by with roughen surface providing a bone in-growth surface medium.

While the prosthesis of Zang, et al is intended for replacement of a phalangeal type joints, the structure as broadly claimed is fully met by the prosthesis of Zang, et al. The prosthesis of Zang, et al is structurally similar to that as illustrated by applicant and the applicant has failed to provide any factual evidence why the device of Zang could not perform the intended task. Therefor, examiner contends that the device of Zang et al is capable of performing the function of replacing all or a portion of the natural facet joint. A side by side view of the applicant's invention and the device of Zang are included below to show the structural similarities.

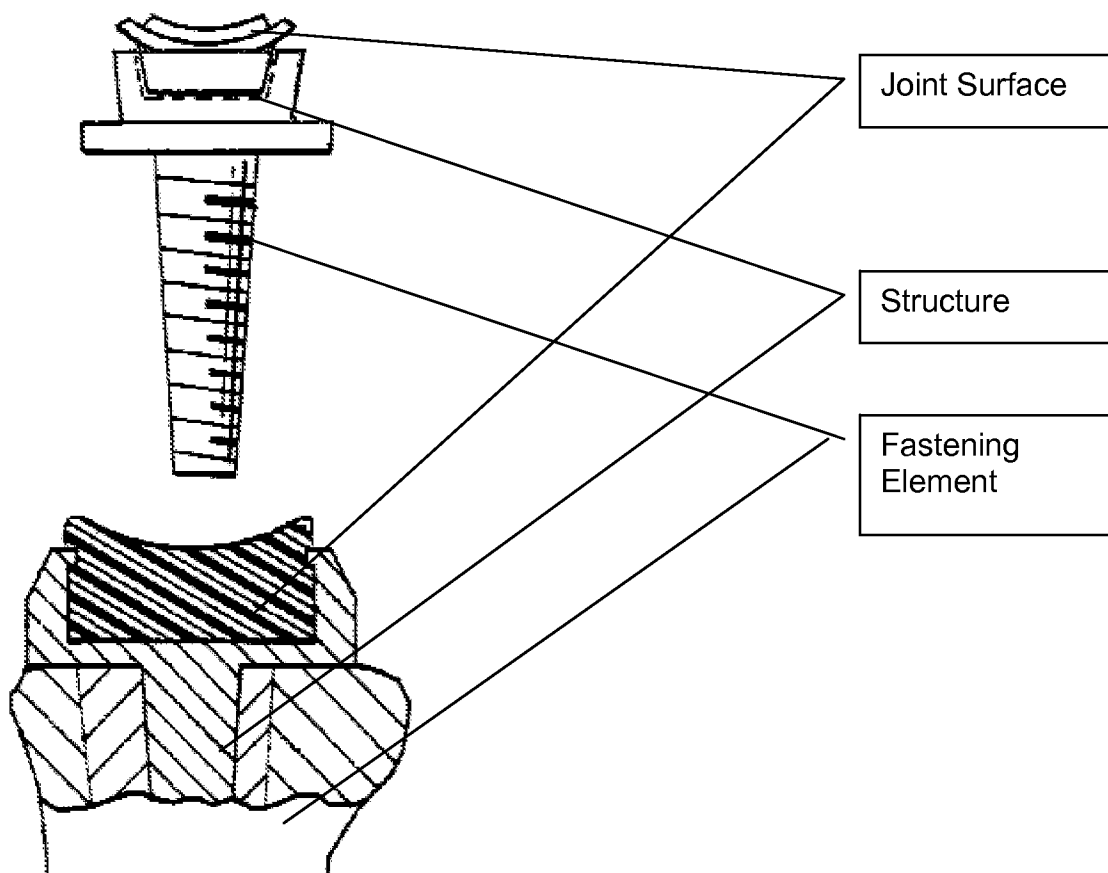
The combination of the fastening element and the facet joint structure of Zang et al is described above as being attached with mechanical means. It is well known in the art of fabricating elements to fastening joint structure using adhesives, Adhesives and mechanical fasteners are well known within the art to be interchangeable components for affixing elements together. The two are essentially known equivalents in the art.

Additionally Zang does not disclose a hexagonal shaped depression in the surface of the structure.

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Vitale teaches the use of a joint implant similar in shape and structure to Zang, but including a hexagonal shaped depression sized to accommodate a driving to in the same field of endeavor for the purpose of aiding in the implantation of the device.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the upper surface of the structure of Zang to include a hexagonal shaped depression as taught by Vitale in order to aid with the implantation of the device.



Response to Arguments

Applicant's arguments with respect to all claims have been considered but are moot in view of the new ground(s) of rejection. In view of the applicant's problem with disclosing a pentagon shaped depression and claiming a hexagonal depression, the applicant must correct the inconsistency, but this will not render the art of record allowable. The choice between hexagonal and any other shape for the driving member would probably be a mere design choice not a novel feature.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER D. PRONE whose telephone number is (571)272-6085. The examiner can normally be reached on Monday through Fri 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher D Prone
Examiner
Art Unit 3738

/Christopher D Prone/

/Corrine M McDermott/
Supervisory Patent Examiner, Art Unit 3738